



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,076	12/13/2000	Bin Xu	020481000700	3262

20350 7590 05/07/2004

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

TRIEU, LAURENT L

ART UNIT

PAPER NUMBER

2137

DATE MAILED: 05/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/739,076

Applicant(s)

XU ET AL.

Examiner

Laurent L Trieu

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-14 have been examined.

Drawings

The drawings are objected to because Figure 3 shows a left arrow pointing into item 308 "Content Player" with no description. Also, arrows in Figures 1, 3, 4 and 5B are not clear, nor are the boxes in Figures 2 and 3. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claim 13 is objected to because of the following informalities: "one of more" is read as "one or more". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 6, 10 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. If header is removed, how is the license inspected ?

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Auerbach et al. US Patent 5,673,316, hereafter referred to as Auerbach.

With regards to claim 1, Auerbach discloses the claimed limitations as follows:

- Identifying the license by using one or more information fields within header – “terms and conditions ... (will be made visible to the user)” (Column 4, lines 52-56)
- Verifying the terms of the license locally on the user-computing device while the user is offline – “terms and conditions on the use of the document parts can also be included in the cryptographic envelope... they will be evaluated at the Buy Server (BS) 102 and possibly again at the user’s personal computer (UPC 101)” (Column 4, lines 52-58).
- Retrieving the license, a session key for decrypting the content file – “decrypts the translated PEKs (602, 603)” (Column 10, lines 57-58) (PEK – Part Encryption Keys)
- Retrieving the license, a segment which is part of the content file – “the DFWM decrypts the corresponding encrypted parts of the cryptographic envelope (203,205)” (Column 10, lines 62-64)

Art Unit: 2137

- Decrypting the content file using the session key to permit playback of the content file for a single session – “the DFWM decrypts the corresponding encrypted parts of the cryptographic envelope (203,205)” (Column 10, lines 62-64)
- Combining the segment with the content file to permit playback of the content file – “5-f--The resultant decrypted documents are released to the user” (Column 11, lines 3-4)

Regarding claim 2 – “Step 4-h - Send BSR to user” (Column 10, line 34) and “After receiving a BSR” (Column 10, line 42).

Regarding claims 3 and 4 – “Encrypted document parts 203 are often the ‘valuable contents’ to be purchased by the user (e.g., a section of a book, a high resolution JPEG picture, or an MPEG stream). Unencrypted parts are the ‘teasers’ 201 (e.g., reviews of the book by others, the table of content, the abstract, or a low resolution JPEG picture)” (Column 4, lines 10-15)

Regarding claim 5 – Auerbach discloses, “Alternatively, it could be triggered by a user request. In this case the cryptographic envelope would be created specifically for the user, and the cryptographic envelope may contain certain information specific to the user or the request” (Column 3, lines 49-53)

Art Unit: 2137

Regarding claim 7 - Auerbach meets the claimed limitations as follows:

- Receiving the content file from a computing system communicatively coupled to the user-computing device – “Step 4-h - Send BSR to user” (Column 10, line 34) and “After receiving a BSR” (Column 10, line 42).
- Receiving the license from a computing system communicatively coupled to the user-computing device - “Step 4-h - Send BSR to user” (Column 10, line 34) and “After receiving a BSR” (Column 10, line 42).
- Optionally, storing both the content file and license within the user computing device to enable future playback of the content file – “After receiving a BSR, the user can open the cryptographic envelope at his convenience” (Column 10, line 42-44) “At his convenience” reads on storing for future playback.
- Retrieving the content file having a header containing one or more information fields – Fig. 2 shows BOM (207) inside the content envelope.
- Identifying the license by using the one or more information fields within header – “terms and conditions ... (will be made visible to the user)” (Column 4, lines 52-56)
- Verifying the terms of the license locally on the user computing device while the user is offline – “terms and conditions on the use of the document parts can also be included in the cryptographic envelope... they will be evaluated at the Buy Server (BS) 102 and possibly again at the user’s personal computer (UPC 101)” (Column 4, lines 52-58).

- Retrieving from the license, a session key for decrypting the content file – “decrypts the translated PEKs (602, 603)” (Column 10, lines 57-58) (PEK – Part Encryption Keys)
- Retrieving from the license, a segment which is part of the content file – “the DFWM decrypts the corresponding encrypted parts of the cryptographic envelope (203,205)” (Column 10, lines 62-64)
- Decrypting the content file using the session key to permit playback for a single session – “the DFWM decrypts the corresponding encrypted parts of the cryptographic envelope (203,205)” (Column 10, lines 62-64)
- Combining the segment with the content file to permit playback – “5-f--The resultant decrypted documents are released to the user” (Column 11, lines 3-4)

Regarding claims 8 and 9 – “Encrypted document parts 203 are often the ‘valuable contents’ to be purchased by the user (e.g., a section of a book, a high resolution JPEG picture, or an MPEG stream). Unencrypted parts are the ‘teasers’ 201 (e.g., reviews of the book by others, the table of content, the abstract, or a low resolution JPEG picture)” (Column 4, lines 10-15)

Regarding claim 10 –

- A key for decrypting the content file – “1-c -- Generate random PEKs (part encryption keys) (Column 5, line 63)
- A first content portion which is part of the content file – “1-g-- Include in the cryptographic envelope clear text parts such as ‘teasers’, abstracts, and a table of content 201” (Column 6, lines 12-14)
- A license for decrypting the content file, the license containing both the key and the first content portion – “The envelope, then, includes the encrypted information parts, the unencrypted information parts, the encrypted part encryption keys and the list of parts” (Column 2, lines 26-28) – wherein the envelope is reads as the ‘license’, the encrypted information parts comprises the ‘content file’, the unencrypted information part comprises the ‘first content portion’ and the encrypted part encryption keys reads on the ‘key’.
- A first computer system for generating the content file, the first computer system further comprising -
A header which contains a first field for having identification information – “1-i--Create a list 209 of information parts, listing all the parts assembled” (Column 6, lines 20-22)
 - Software containing one of more instructions for creating the header – “1-i-
-Create a list 209 of information parts, listing all the parts assembled”
(Column 6, lines 20-22)

Art Unit: 2137

- Software containing one or more instructions for generating the key – “1-c-Generate random PEKs (part encryption keys) 202” (Column 5, line 63)
- A second computer system for receiving the content file from the first computer system and for receiving the license, the second computer system further comprising,
 - Software containing one or more instructions for verifying the terms of the license locally on the second computer system while the user is offline – “5-b-
-The user may optionally be prompted with the updated licensing terms and conditions 605 in the BSR” (Column 10, lines 54-55) and “After receiving a BSR, the user can open the cryptographic envelope at his convenience” (Column 10, lines 42-44) where “at his convenience” comprises ‘while the user is offline’.
 - Software containing one or more instructions for decrypting the content file using the key, upon receipt of the license – “5-d--Using the decrypted PEKs, the DFWM decrypts the corresponding encrypted parts of the cryptographic envelope (203,205)” (Column 10, lines 62-64)

Regarding claim 11 –

- A key for decrypting the content file – “Each part encryption key is also encrypted with a public key” (Abstract)

Art Unit: 2137

- A first content portion which is part of the content file – “The envelope, then, includes the encrypted information parts, the unencrypted information parts, the encrypted part encryption keys and the list of parts” (Column 2, lines 26-28) – wherein the unencrypted information part comprises the ‘first content portion’.
- A license for decrypting the content file, the license containing both the key and the first content portion - “The envelope, then, includes the encrypted information parts, the unencrypted information parts, the encrypted part encryption keys and the list of parts” (Column 2, lines 26-28) – wherein the envelope is reads as the ‘license’, the unencrypted information part comprises the ‘first content portion’ and the encrypted part encryption keys reads on the ‘key’.
- A second computer system for receiving the content file from the first computer system and for receiving the license, the second computer system further comprising
 - Software containing one or more instructions for identifying the license using the header – “terms and conditions ... (will be made visible to the user)” (Column 4, lines 52-56)
 - Software containing one or more instructions for verifying the terms of the license locally on the second computer system while the user is offline – “5-b– The user may optionally be prompted with the updated licensing terms and conditions 605 in the BSR” (Column 10, lines 54-55) and “After receiving a

BSR, the user can open the cryptographic envelope at his convenience”
(Column 10, lines 42-44) where “at his convenience” comprises ‘while the user is offline’.

- Software containing one or more instructions for decrypting the content file using the key, to permit playback of the content file while the user is offline -
“5-d--Using the decrypted PEKs, the DFWM decrypts the corresponding encrypted parts of the cryptographic envelope (203,205)” (Column 10, lines 62-64) and “After receiving a BSR, the user can open the cryptographic envelope at his convenience” (Column 10, lines 42-44) where “at his convenience” comprises ‘while the user is offline’.

Regarding claim 12 – claim 11 wherein the header contains one or more information fields for identifying the license – “Every cryptographic envelope has a special control part called BOM (Bill of Materials) 207” (Column 5, lines 15-18)

Regarding claim 13 – claim 11 wherein the first computer system has software containing one of more instructions for creating the header – “1-i—Create a list 209 of information parts, listing all the parts assembled and computing a secure hash for each of the parts listed. 1-j—Create a signature 208 for BOM 207... The BOM 207 (list 209 and signature 208 are added to cryptographic envelope” (Column 6, lines 20-27)

Art Unit: 2137

Regarding claim 14 – claim 11 wherein the first computer system has software containing one or more instructions for generating the key – “1-c-Generate random PEKs (part encryption keys) 202” (Column 5, line 63)

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 6,021,491 to Renaud – “Digital Signatures for Data streams and data archives”.

US Patent No. 5,933,498 to Schneck et al. – “System for controlling access and distribution of digital property”.

US Patent 6,209,095 B1 to Anderson et al.– “Method and system for processing electronic documents”.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurent L Trieu whose telephone number is 703-305-0712. The examiner can normally be reached on M-F 8AM-4PM (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Morse can be reached on 703-308-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2137

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LLT
28 April 2004

Art Unit 2137


GREGORY MORSE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100